

II. **REPLY TO REJECTION OF CLAIMS 1, 3 AND 5 UNDER 35 USC §103(a)**

A. Summary of the Rejection

Claims 1, 3 and 5 have been rejected under 35 USC §103(a) as unpatentable over US Patent No. 5,838,364 (“the ‘364 patent”) to Ishibe et al (“Ishibe ‘364”) in view of US Patent No. 5,710,425 (“the ‘425 patent”) to McConica et al (“McConica”). The Office Action admits that Ishibe ‘364 does not disclose “a scanning surface”, a structural element required by these rejected claims.

B. Reply Re Rejection to Claims 1, 3 and 5

It appears that the Office Action alleges that all elements of claims 1, 3 and 5 are found in Ishibe ‘364 except a scanning surface, and that McConica ‘425 discloses a scanning surface, thus rendering these claims unpatentable. In reply Applicants will show that the rejection is an improper “hindsight” rejection, that Ishibe and McConica teach away from each other, that there is no motivation to combine the teaching of these two cited references and that if combined in accordance with their actual teachings, would yield a structure not as claimed by Applicants.

McConica ‘425 discloses a scanner 100 with a base 105, upon which a target 115 is placed for scanning. The scanner 100 may scan both transparent targets, such “as in the case of a 35 mm slide or negative strip” [2:61-66], or an opaque target, “as in the case of a document or photograph” [2:29-32]. McConica ‘425 has no disclosure of any memory capacity, and, as

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disclosed at [2:53-60] has only the capability to “send image data to a microprocessor-based system, including a computer or a printer, via link 161.” [2:53-60].

With respect to Ishibe, as shown in Figures 1-4 the ‘364 patent teachings are limited to two embodiments; in one of which a cartridge is positioned in a cavity in the housing, and in the other of which a film slot 8 is provided in the side surface of the housing for permitting a strip of film to be fed through the slot. In neither of these embodiments does the housing have any “scanning surface.”

In regard to the cartridge embodiment, no description is provided about the cartridge sufficient to determine whether it, in turn has a scanning surface. Thus, with respect to the cartridge embodiment it may be true that no scanning surface is provided in either the cartridge or the film player housing, and it is certainly true that no such scanning surface is provided by the housing itself.

In regard to the piece of film embodiment no other structure is provided as a scanning surface. Thus, it is the piece of film itself that is the scanning surface; not the housing that provides for a scanning surface as claimed.

While the Office Action states that the reason for combining the teachings of McConca’s “scanning surface” structure with the disclosed structure of Ishibe is that “the scanners of both McConica et al. and Ishibe et al. are for scanning film strip (or piece film), it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the scanner housing and structure of Ishibe et al. to provide a housing having a scanning surface

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thereon on which film strip is placed during scanning, in order to provide a scanner having a structure which allows generation of image data not only from a film but also from an opaque original, increasing the flexibility in the kinds of originals.” Office Action at 3.

McConica has no disclosure in regard to any goal or applicability of his scanner for speedy reproduction of still images. Rather, McConica is concerned with the goal of providing two separate magnifications for still images that are either opaque or, alternatively, transparent. In this regard McConica always employs a lamp 125 that “projects a narrow line of light off a pivoting illumination mirror 175” to form an image through one of two paths of light formed by a series of mirrors. [‘425 patent at 2:29-33 and Figure 1A]. In sharp contrast, Ishibe ‘364 is concerned with speedy copying of only film, i.e., “. . . to provide a still image reproducing apparatus which can save the time for reproducing the images.” [‘364 patent at 1: 44-46]. Ishibe discusses the structure and method of McConica as being undesirable for his purposes, for the reason that it is too slow. Indeed, Ishibe’s invention is an attempt to improve upon and to avoid the slowness that is necessarily associated with the technology employed in the McConica scanner. In discussing the narrow line type scanning of McConica, Ishibe had this to say:

“ . . . In such an apparatus, original still images are taken by a pickup element such as an area sensor or a line sensor and converted to electric signals, which in turn are displayed on a display unit such as a television. In this case, however, a long time is required for taking the original still images. Particularly when a line sensor is employed, it is necessary to scan each frame for taking the still images with a considerably long time. Thus, the time for still image reproduction is lengthened by such a taking operation.”

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[‘364 patent, at 1:18-29].

Thus, from the above passage in Ishibe, it is readily apparent that Ishibe teaches away from McConica, and that the combination proposed in the Office Action is improper hindsight.

With respect to Ishibe, Applicants would also emphasize that no specific structure in Ishibe ‘364 is identified as the “supporting surface.” Thus, Applicants have not been placed on factual notice of what the Patent Office considers to be a prior art structure that is necessary to meet a burden of establishing anticipation. Alternatively, if the Office Action was intended to admit that Ishibe does not have any supporting surface structure, and that incorporating the structure of McConica would provide such a structure, then Applicants would emphasize the reasons, stated above in detail, on why the references teach away from such a combination: McConica wants multi resolution capability for two types of objects and is satisfied with slow image capture by a single, narrow line scanner; Ishibe wants fast scanning and display of a single type of image and cannot tolerate the slow image capture resulting from the single, narrow line scanner structure of McConica. The teachings of the two cited references are not compatible with each other. Indeed, they are mutually exclusive. To meet the goals of either, the technology of the other will not work and will yield a structure that will not work for its intended purpose. While the Office Action suggests combining the McConica structure with Ishibe to increase flexibility in the kinds of originals, it is clear from Ishibe that he does not want such flexibility at the price of the slow speed of image capture that would necessarily result.

Also, since it appears that the Office Action concedes that Ishibe does not have a

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scanning surface structure, there is no reason to add such structure and then penalize the resultant structure with so much slowness that it would not work for its primary intended purpose – rapid scanning of still images.

For each and every one of the reasons stated above it is believed that the rejection to claims 1, 3 and 5 is in error and should be withdrawn.

III. REPLY TO REJECTION OF CLAIM 4 UNDER 35 USC §103(a)

A. Summary of the Rejection

Claim 4 has been rejected under 35 USC §103(a) as unpatentable over the Ishibe '364 patent in view of the McConica '425 patent and further in view of US Patent No. 5,754,713 (The '713 patent") to Deguchi et al. ("Deguchi"). The Office Action admits that neither Ishibe '364 nor McConica '425 disclose a removable data storage medium, as required by claim 4.

B. Reply Re Rejection to Claim 4

Because claim 4 depends from claim 1 the rejection should be withdrawn for the same reasons as set forth above in regard to claim 1, which reasons are incorporated herein by reference.

Specifically with respect to claim 4, Deguchi describes an image reading device that has a bottom side 2 having a "reading use window" and a top side having a "confirming use window"

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3 and a “display” 4. This device is used to “simplify and shorten the scrapbook-making job for newspaper articles.” (column 10, lines 58-60). The device is placed on a newspaper page with the window 2 facing down and the window 4 and display 4 facing up to the user. (e.g., column 2, lines 48-60) The user is then able to view the part of the newspaper that will be scanned, and is able to adjust the position of the device so that it scans the desired newspaper article.

In reply to the grounds asserted in the rejection and specific to claim 4, Applicants would point out that the Office Action has failed to establish *prima facie* obviousness. In order to establish *prima facie* obviousness, a suggestion, motivation or teaching to make the claimed combination must be found in the cited prior art. Here there is none.

First, as discussed above, the Ishibe ‘364 device is not a stand alone flatbed scanner and does not have a scanning surface as claimed. As is readily apparent from the figures and written description of the ‘713 patent its image-reading device is not a stand alone flatbed scanner, and it does not have a scanning surface as claimed. Thus, even if some motivation existed to modify the Ishibe ‘364 film reader with the McConica structure and further to incorporate a removable storage medium, as suggested in the Office Action the result would not be a scanner as claimed. It simply is not possible to combine the teachings of three devices, the primary and one of the secondary references of which are not stand alone flatbed scanners and do not have a scanning surface so that the resulting combination is a stand alone flatbed scanner that does have such a scanning surface. For this reason alone the rejection should be withdrawn.

Assuming *arguendo* that a combination of the teachings of the three references would

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result in a flatbed scanner, nevertheless there is no suggestion, motivation or other reason in any of the references to the effect that they should or could be combined. To the contrary, the references themselves teach away from such a combination. The Ishibe '364 film reader is for rapid reproducing of one frame of a film after the other, has a CPU 40 for processing the digital signals that result from the scanning of successive frames of the film and send the processed images to a television. The main objective of Ishibe is to have the capability of rapidly reproducing each subsequent frame on the film. Thus, "external" processing is not necessary because it would duplicate the processing capability already incorporated into the Ishibe device and "external" output would necessarily be undesirable because it would consume precious time needed by the system to reproduce each subsequent frame on the film and would otherwise appear to simply be a basis for duplicating the processing that already takes place in the Ishibe '364 system. Thus, the teachings of Ishibe actually teach away from the combination proposed in the Office Action. The teachings of Deguchi '713 further expose the proposed combination to be the result of a hindsight analysis. Whereas Ishibe is directed to frames of film that are reproduced and displayed on a television, Deguchi is directed to making scrapbooks from newspaper articles. These are very disparate fields of invention, and there is no teaching in Deguchi to the effect that any improvement to the television images of frames of film would result if an additional memory was used. As demonstrated above, the important objective for Ishibe is speed, not flexibility or portability. These later two objectives are pure Office Action-based speculation in a hindsight evaluation of Applicants' invention; not on any motivation

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found in the prior art.

For the reasons discussed above it is apparent that the rejection is based on a hindsight analysis, and therefore should be withdrawn.

IV. REPLY TO REJECTION OF CLAIMS 6-9 AND 11 UNDER 35 USC §103

A. Summary of the Rejection

Claims 6-9 and 11 have been rejected under 35 USC §103(a) as unpatentable over McConica '425 in view of "Applicant's admitted prior art."

B. Reply Re Claims 6-9 and 11

In reply to the specific grounds asserted in the rejection of claims 6-9 and 11, Applicants would point out that the Office Action has failed to establish *prima facie* obviousness. In order to establish *prima facie* obviousness, a suggestion, motivation or teaching to make the claimed combination must be found in the cited prior art. Here there is none.

The language of independent claim 6, as presently amended, requires the stand alone CPU to be without a display device. Thus, the system of claim 6 is one illustrated in Figure 23: a scanner that is not a display device, such as a television monitor; a stand alone CPU that is not a scanner and is not a display device, such as a television; and a stand alone display device that is

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adapted to receive the digital data from the stand alone CPU, which in turn receives digital data from the stand alone scanner. The office action has not shown any prior art disclosing the subject matter of these claims, as amended.

V. REPLY TO REJECTION OF CLAIM 13 UNDER 35 USC §102(b)

Claim 13 has been rejected under 35 USC §102(b) as unpatentable over McConica '425.

As presently amended, the method of claim 13 requires scanning an image with installed software that is adapted to convert the obtained image data to digital data adapted for transmission directly to a display device. As is readily apparent the McConica '425 scanner transmits image data that then must be processed by the software on the remote computer to put it in digital form adapted for transmission directly to a display device. As such, the McConica '425 scanner does not anticipate claim 13 and it is requested that the rejection be withdrawn.

VI. REPLY TO REJECTION OF CLAIM 14 UNDER 35 USC §103(a)

Claim 14 has been rejected under 35 USC §103(a) as unpatentable over McConica '425 in view of Deguchi '713.

Because claim 14 depends from claim 13 and claim 13 has been amended, it is believed that claim 14 is patentable for the same reasons as is claim 13.

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VII. ACKNOWLEDMENT OF ALLOWABILITY OF THE SUBJECT MATTER OF
CLAIMS 2, 10, 12 AND 15-20

The allowability of the subject matter of claims 2, 10, 12 and 15-20 is acknowledged with thanks. These claims have been amended to place them in independent form.

VIII. AUTHORIZATION TO CHARGE FEES

Authorization is hereby granted to charge Deposit Account No. 50-3725 for additional fees due.

IX. CONCLUSION

For all of the above reasons, it is believed that the above-identified patent application is now in condition for allowance.

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Respectfully submitted,

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